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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,067	12/04/2001	Makoto Kitamura	018976-211	9557

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EXAMINER

NGUYEN, THUKHANH T

ART UNIT	PAPER NUMBER
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1722

9

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/000,067		KITAMURA ET AL.	
	Examiner		Art Unit	
	Thu Khanh T. Nguyen		1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-65 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, drawn to a power molding apparatus with a molded article holding means, classified in class 425, subclass 422.
 - II. Claims 7-14, drawn to a powder molding apparatus with a punch positioning means, classified in class 425, subclass 355.
 - III. Claims 15-19 and 36-64, drawn to a powder molding apparatus with a linking means, classified in class 425, subclass 451.
 - IV. Claims 20-35, drawn to a powder molding apparatus with an unit holding means, classified in class 425, subclass 453.
 - V. Claim 28, drawn to a powder molding apparatus with a molded articles holding means, a punch positioning means, a linking means and an unit holding means, classified in class 425, subclass 345.
 - VI. Claim 65, drawn to a powder supply device, classified in class 425, subclass 219.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-V and VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed in group VI because the combination could have use a feed

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regulating valve instead of a powder storing unit and a scraping blade. The subcombination has separate utility such as feeding particles into a fluidizer.

3. Inventions I & V and II-IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the powder molding apparatus as disclosed in groups II- IV does not require the molded article holding means. The subcombination has separate utility such as thermoforming a plastic sheet.

4. Inventions II & V and I, III-IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the powder molding apparatus as disclosed in groups I, III-IV does not require the punch positioning means. The subcombination has separate utility such as encapsulating semiconductor devices.

5. Inventions III & V and I-II & IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the

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particulars of the subcombination as claimed because the powder molding apparatus as disclosed in groups I-II & IV does not require a linking means. The subcombination has separate utility such as forming an article with different sizes or shapes by using interchangeable molds connected by the linking means.

6. Inventions IV & V and I-III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the powder molding apparatus as disclosed in groups I-III does not require a unit holding means. The subcombination has separate utility such as forming multi-layer tablets, while the unit holding means holding the lower punch, which holds different powder material in a die.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

8. If the Applicants select group I, claims 1-6, this group contains claims directed to the following patentably distinct species of the claimed invention, and one of the species should be selected:

- a. Claim 2: upper and lower punch units – Figures 13 (A-B) – 15 (A-B)
- b. Claim 3: an engaging piece – Figure 16A
- c. Claim 4: a guide member – Figure 16B
- d. Claim 5: a pressing mechanism – Figure 16 C-D

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- e. Claim 6: fluid pressure generating means – Figure 16 E-F

9. If the Applicants select group II, claims 7-14, this group contains claims directed to the following patentably distinct species of the claimed invention, and one of the species should be selected:

- a. Claims 8-9: a tapered block – Figures 5- 7 (A-B)
- b. Claim 10: guide pins – Figure 18

10. If the Applicants select group III, claims 15-19 and 36-64, this group contains claims directed to the following patentably distinct species of the claimed invention, and one of the species from each of the sub-groups (i, ii) should be selected:

i) Slide driving means:

- a. Claim 18: Linearly driven means – Figures 8-10
- b. Claim 19: Rotationally driven means – Figures 20-21

ii) Fixing means:

- a. Claim 38: a fixing bush – Figure 43
- b. Claim 39: an actuator – Figures 44 (A-B)
- c. Claim 40: a fluid pressure fixing member – Figures 45-46

11. If the Applicants select group IV, claims 20-35, this group contains claims directed to the following patentably distinct species of the claimed invention, and one of the species should be selected:

- a. Claims 22-24 and 30-32: a fastening lever – Figures 22-23

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b. Claims 25-27 and 33-35: a cam member – Figures 31-40. If the Applicant chooses to select this group, a further species restriction is required:

i) Claims 26 and 34: a rotating cam – Figures 37-38

ii) Claims 27 and 35: a linear cam – Figures 39-40

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 7, 21, 29 and 36 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the

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prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

12. A telephone call was made to Mr. Harold Brown III on July 9, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Khanh T. Nguyen whose telephone number is 703-305-7167. The examiner can normally be reached on Monday- Friday, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

TN
July 14, 2003



ROBERT DAVIS
PRIMARY EXAMINER
GROUP 1300 1700

7/14/03